REMARKS

Applicant requests that the Examiner consider the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on March 21, 2003 and return an initialed copy of the PTO-1449 form, thereby confirming that the listed references have been considered.

Claims 1-37 have been examined on their merits.

Applicant herein editorially amends claims 13-37 to remove the "step" language from the claims. The amendments to claims 13-37 were made merely to more accurately claim the present invention and do not narrow the literal scope of claims 13-37 and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 13-37 were not made for reasons of patentability.

Claims 1-37 are all the claims presently pending in the application.

1. Claims 13, 15, 16, 19, 20, 25, 26, and 28 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Fushiki *et al.* (U.S. Patent No. 6,480,201). Applicant traverses the rejection of claims 13, 15, 16, 19, 20, 25, 26 and 28 for at least the reasons discussed below.

Fushiki *et al.* is cited as prior art under 35 U.S.C. § 102(e), based upon its U.S. filing date of August 24, 1999. Fushiki *et al.* can be removed as a reference by demonstrating that the invention disclosed in the present application was conceived prior to the Fushiki *et al.* U.S. filing date, followed by diligence leading to the constructive reduction to practice of the present

invention. Constructive reduction to practice may be demonstrated by the filing of a patent application.

In the instant case, the invention was conceived prior to August 24, 1999. Evidence of the inventor's conception and diligence leading to constructive reduction to practice is demonstrated through a Rule 131 affidavit (filed concurrently herewith) of the inventor, Mr. Erich Guenther.

With removal of Fushiki *et al.* as a prior art reference, Applicant respectfully submits that the 35 U.S.C. § 102(e) rejection of claims 13, 15, 16, 19, 20, 25, 26, and 28 has been overcome.

2. Claims 1-12, 14, 17, 18, 21-24, 27 and 29-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Breyer *et al.* (U.S. Patent No. 6,256,625) in view of Fushiki *et al.* Applicant traverses the rejection of claims 1-12, 14, 17, 18, 21-24, 27 and 29-37 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

b) The proposed modification of the prior art must have had a reasonable expectation of

success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not "evidence." *Id.; see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner acknowledges that the difference between Breyer *et al.* and the claims is the multiple images comprised of a base image and secondary images. *See, e.g.*, September 4, 2004 Non-Final Office Action, page 3. The Examiner cites Fushiki *et al.* as providing the necessary teaching to overcome the acknowledged deficiency of Breyer *et al.*

In the instant case, the invention was conceived prior to August 24, 1999. Evidence of the inventor's conception and diligence leading to constructive reduction to practice is

demonstrated through a Rule 131 affidavit (filed concurrently herewith) of the inventor Mr. Erich Guenther.

With removal of Fushiki *et al.* as a prior art reference, Applicant respectfully submits that the Examiner cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness. Applicant submits that the 35 U.S.C. § 103(a) rejection of claims 1-12, 14, 17, 18, 21-24, 27 and 29-37 has been overcome.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Paul J. WilsonT
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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CUSTOMER NUMBER

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